



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,888	08/26/2003	George Vais	VAIG103	4868

7590 11/30/2004

DEREK H. MAUGHAN
DYKAS, SHAVER & NIPPER, LLP
P.O. BOX 877
BOISE, ID 83701-0877

EXAMINER

THOMSON, MICHELLE R

ART UNIT	PAPER NUMBER
3641	

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/648,888	VAIS, GEORGE
	Examiner Michelle (Shelley) Thomson	Art Unit 3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 September 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 April 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/16/04 have been fully considered but they are not persuasive. In regards to applicant's arguments that the prior art does not disclose an assembly system comprising three separate pieces, it is noted that initially these arguments do not apply to Claim 1 since Claim 1 does not claim three separate pieces. Furthermore it is noted that both Swan and Morris disclose "an assembly system comprising three separate pieces" as required by current claims 2 and 3 of the present application. The assembly system of Swan is clearly seen in Figure 18 as comprising 3 separate pieces and the assembly system of Morris is clearly seen in Figure 8 as comprising 3 separate pieces. Applicant's arguments are narrower than the scope of the present claims, which merely require the assembly system comprising three separate pieces. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. In response to applicant arguments that the prior art barrel nuts are single piece units, it is noted that applicant has also disclosed a single piece barrel nut (reference 10), applicant's barrel nut is also combined with other components (i.e. gas ring adapter 130 and locknut 140) to make up applicant's assembly system. Similarly, although the prior art discloses a single piece barrel nut, the barrel nut is combined with other components to make up the assembly system. It is the system as a whole that is considered when applied to applicant's current claims. It is irrelevant that the barrel nut of the prior art is the only item that actually functions to hold a barrel to an upper receiver (cmt. 10), applicant has not claimed and/or disclosed otherwise. Applicant's arguments with respect to the sight are also irrelevant in that applicant's claims are not directed to a device in conjunction with a sight. Applicant's arguments

amount to a general allegation that the claims define a patentable invention without specifically pointing out how *the language of the claims* patentably distinguishes them from the references.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification fails to provide antecedent basis for the terms used in the claims, applicant should maintain consistency in term usage between the claim language and the specification language for clarity. The specification fails to provide proper antecedent basis for the following terms: connection sleeve (for the remainder of the action the examiner will assume this refers to applicant's barrel nut 110); stabilizing device (claim 1) (it is not clear to the examiner what this is referring to since applicant has not disclosed a device that prevents axial rotation of the barrel nut, applicant has however disclosed threaded portions, it is the examiner's position that the threaded portion are configured to prevent axial rotation of the barrel nut); locking device (the examiner takes the position that this is locknut 140); gas tube stabilizing device (the examiner considers this gas ring adapter 130). Correction is required.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Where the written description only implicitly or inherently sets forth the structure, materials, or acts corresponding to a means-plus-function, applicant must clarify the disclosure to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the function recited in the claim elements and equivalents thereof. (See MPEP 2181). Correction of the following is required: applicant must **clarify the disclosure to explicitly state, with**

reference to the terms and phrases of the claim element, what structure, materials, or acts perform the retaining means, gas tube stabilizing means, stabilizer means, and locking means recited in the claim elements and equivalents thereof. Correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 2 recites the limitations "said rifle barrel receiver" in line 6 and "said rifle barrel" in line 7. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 3 recites the limitations "said rifle barrel receiver" in line 7 and "said rifle barrel" in line 8. There is insufficient antecedent basis for this limitation in the claim.

8. Claims 1-3 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-3 recite an assembly system and a corresponding intended use for the assembly system (i.e. the assembly system for connecting a gun barrel to a gun . . .) however the statements of intended use or field of use, clauses are essentially method limitations and are not positively cited as structural limitations since applicant has not claimed the assembly system in combination with such a gun barrel and gun having a gas tube. Therefore the recitation of the structural members, which have not previously been positively, recited (i.e. "said gas tube" in

claim 2, line 10) is inconsistent; rendering the claim indefinite in that it is not clear whether applicant intends the gas tube to be encompassed by the claim language.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Swan (US Patent # 6,499,245). Swan discloses an assembly system comprising three separate pieces (Figure 18).

The system comprising a connection sleeve (reference 170) defining a generally longitudinal bore extending from a first end along a longitudinal axis to a second end, and having a portion that has the ability to connect with a rifle barrel receiver and a portion having the ability to connect with the rifle barrel and the ability (retaining means) to maintain the rifle barrel within the connection sleeve; a stabilizing device having the ability to prevent axial rotation of the connection sleeve (reference 162); and a locking device (reference 164) having an infinite number of locking positions (inasmuch as applicant has disclosed an infinite number of locking positions as the locking device is threaded onto the connection sleeve) having the ability to hold the stabilizing device in a desired position. The system further comprising a gas tube stabilizing device/means having a portion that has the ability to receive a portion of a gas tube therein and having the ability (stabilizing means) to prevent rotation of the gas tube stabilizing device about

the longitudinal axis (column 5, lines 13-27). The [a)statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"]clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

10. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Morris (US Patent # 4,765,224). Morris discloses an assembly system comprising three separate pieces (Figure 8). The system comprising a connection sleeve (reference 44) defining a generally longitudinal bore extending from a first end along a longitudinal axis to a second end, and having a portion that has the ability to connect with a rifle barrel receiver and a portion having the ability to connect with the rifle barrel and the ability (retaining means) to maintain the rifle barrel within the connection sleeve; a stabilizing device having the ability to prevent axial rotation of the

connection sleeve (reference 56); and a locking device (reference 38) having an infinite number of locking positions (inasmuch as applicant has disclosed an infinite number of locking positions as the locking device is threaded onto the connection sleeve) having the ability to hold the stabilizing device in a desired position. The system further comprising a gas tube stabilizing device/means having a portion that has the ability to receive a portion of a gas tube therein and having the ability (stabilizing means) to prevent rotation of the gas tube stabilizing device about the longitudinal axis (Figure 6). The [a]statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"]clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Thomson whose telephone number is 703.306.4176. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 703.306.4198. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mrt

A handwritten signature in black ink, appearing to read "M. F. Thomson".